

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte BENJAMIN A. LAGRANGE and TIMOTHY B. LLOYD

Application 10/774,399
Technology Center 3700

DECISION ON PETITION

This is a decision on the "Petition Requesting Withdrawal of Erroneous Abandonment or In the Alternative to Revive an Unintentionally Abandoned Application," filed February 9, 2009 ("Petition"). The Petition seeks:

Withdrawal of what is believed to be an erroneous abandonment [or] if it is determined that the Examiner's dismissal of the appeal and abandonment of this case was proper then ... revival of this unintentionally abandoned application.

Petition, pp. 1-2.

See 75 Fed. Reg. 15,690 (Mar. 30, 2010) for authority of the Chief Administrative Patent Judge.

FINDINGS

1. On March 8, 2008, Appellants filed an Appeal Brief.

2. On May 5, 2008, the Examiner issued a Notification of Non-Compliant Appeal Brief.
3. On June 5, 2008, Appellants filed a Replacement Appeal Brief.
4. On August 12, 2008, the Examiner issued a Second Notification of Non-Compliant Appeal Brief, noting that the summary of claimed subject matter was not in compliance with 37 C.F.R. § 41.37(c)(1)(v). Specifically, the Examiner held the Brief non-compliant because “[T]he reference numerals provided in parentheses need to appear immediately adjacent to the claim limitations that they refer to . . .”
5. 37 C.F.R. § 41.37(c)(1)(v) provides:

Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.
6. On September 11, 2008, Appellants filed a Second Replacement Appeal Brief.
7. On December 9, 2008, the Examiner issued a Communication Re: Appeal dismissing the appeal and noting that the “corrected Appeal Brief filed September 11, 2008 did not overcome all of the reasons for noncompliance of which the Appellant was notified.” The Communication also noted that the application had been abandoned.
8. On December 18, 2008, the SPE issued an Examiner-Initiated Interview Summary setting forth the substance of a telephonic interview between the SPE and Appellants’ Attorney on December 16, 2008. In the interview, the SPE confirmed the correctness of the Examiner’s actions.
9. On February 9, 2009, Appellants filed the present Petition and a Third Replacement Appeal Brief. The Brief was unsigned.

10. 37 C.F.R. § 1.4(d) requires that all papers submitted to the USPTO must be signed in handwriting or with an S-signature.
11. Review of the Third Replacement Appeal Brief reveals that except for the missing signature, the Brief is in compliance with applicable rules.
12. In the Petition, Appellants argue that the holding of abandonment should be withdrawn because the Second Replacement Appeal Brief was in compliance with 37 C.F.R. § 41.37(c)(1)(v) in respect to placement in the claims of citations to the specification and drawings. Petition, pp. 2-5.
13. As described above in Findings 4 and 8, the Examiner and SPE interpreted Rule 41.37(c)(1)(v) to require that such citations must immediately follow the recitation of each claim element.
14. In response to this interpretation, Appellants argue that prior to the Interview with the SPE –

Nowhere is there a requirement that the reference characters must be repeated throughout a claim limitation so as to be adjacent to every conceivably possible claim element, as now required by the Examiner.

Petition, p. 4.
15. Alternatively, Appellants seek withdrawal of the holding of abandonment and an extension of time to respond to the Second Notification of Non-Compliant Appeal Brief because the Examiner's comment in such Notification concerning the required citations in the claims was ambiguous. Petition, p. 5.
16. The Second Notification of Non-Compliant Appeal Brief states that extensions of time for filing a response are available under 37 C.F.R. § 1.136, which, pursuant to § 1.136(a), includes extensions of time of up to five months from the original due date.

17. The original due date for filing a response to the Second Notification of Non-Compliant Appeal Brief was September 12, 2008. Thus, if the maximum extension of time available under Rule 1.136(a) of five months is added to this original due date, the due date for filing a replacement brief was February 12, 2009.

18. Also, alternatively, Appellants seek revival of the application on grounds that it was abandoned unintentionally. Petition, p. 6.

DISCUSSION

As described above, the Examiner and SPE have interpreted Rule 41.37(c)(1)(v) to require that for each claim element included in the Summary of Claimed Subject Matter, citations to the specification and drawings, where the element is described and illustrated, must immediately follow recitation of the element. This is a reasonable interpretation of the Rule, resulting in the greatest clarity of description of the claimed subject matter.

However, as expressed in the Second Notification of Non-Compliant Appeal Brief – “[T]he reference numerals provided in parentheses need to appear immediately adjacent to the claim limitations that they refer to . . .” Finding 4 – the Rule is silent as to a requirement that it applies to **all** of the elements of each claim as set forth in the Summary of Claimed Subject Matter as opposed to selected claim features. Finding 14. Thus, as expressed in the Second Notification of Non-Compliant Appeal Brief, ambiguity exists as to the extent of applicability of the Rule.

As indicated above, Finding 9, the Third Replacement Appeal Brief, filed February 9, 2009, was filed within five months from the original due date for a response to the Second Notification of Non-Compliant Appeal

Brief. Further, except for a missing signature, the Third Replacement Appeal Brief is in compliance with applicable rules. Finding 11.

DECISION

In view of the foregoing, the Petition is GRANTED to the extent that the holding of abandonment is withdrawn and Appellants are granted a five month extension of time to file a response to the Second Notification of Non-Compliant Appeal Brief, or until February 12, 2009. Thus, the Third Replacement Appeal Brief, filed on February 9, 2009, was timely filed. The fee for such extension will be charged to the Account of Appellants' Attorney as authorized in the Petition, p. 5.

As indicated above, the Third Replacement Appeal Brief was unsigned. Appellants are given a period of one month from the mailing date hereof to submit a properly signed signature page for this Brief.



Michael R. Fleming
Chief Administrative Patent Judge

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